

REMARKS

Interview Summary

Counsel for Applicants wishes to sincerely thank Examiner Lam for extending the courtesy of a personal interview held at the USPTO on July 24, 2008. During the course of the interview, the Examiner's interpretation of the "overflow tube" of Liu (USP 6,924,107) as an equivalent of the "collection duct" of the claimed invention was discussed. The Examiner appeared to agree that the claim amendments submitted herewith should overcome, at least, the outstanding 35 U.S.C. 103 rejection over the same reference.

Status of the claims

Claims 1-55 were pending in the subject application, yet only claims 1-39 were under active consideration. Claims 40-55 are withdrawn from consideration. No claims have been canceled or newly added with this submission. However, claims 1, 18, and 24 have been amended. One of ordinary skill in the art would find support for the amendments from the Figures and discussion at [0043] of the specification as-filed. Therefore, upon entry of this Response, claims 1-55 will remain pending of which claims 1-39 will be under active consideration.

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claim rejections under 35 U.S.C. § 103

In order to establish a *prima facie* case of obviousness, the Office must, at the very least, establish that a single prior art reference or a combination of references teaches or suggests each and every feature of the claimed invention. As will be next expounded, Applicants respectfully submit that the cited references fail in this respect. Hence, Applicants respectfully traverse the rejections.

1. Liu

Claims 1-6, 10-18 and 22-39 remain rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over USP No. 6,924,107 to Ben Liu (“Liu”). In the last-filed Response, Applicants argued, in part, that Liu’s device cannot achieve any of the flow rates for in-line screening of blood that are described in paragraph [0043] and recited in claims 7-9 of the instant application. It was argued that Liu’s device was designed “to *reduce* the volume of the biosample solution in each [successive] capillary” by configuring subsequent arrayer capillaries “to have a *smaller* diameter than the [previous] arrayer capillaries.” Col. 11, lines 57-67; and col. 12, lines 1-9 (emphases added). In contrast, Applicants noted that the claimed device’s chambers were “designed to have a cross-sectional area that is *no smaller* than that of the commonly used collection tube.” Paragraph [0077], (emphases added). The claims were amended to recite this feature.

With the outstanding Office Action, the Examiner does not appear to refute the aforementioned distinction. Rather, she notes “that none of these disclosures relate to the overflow tube (equivalent to the claimed collection duct) or suggest that the overflow tube must be smaller than the capillaries to which it is fluidly connected.” Office Action, page 16. In other words, the Examiner appears to disagree that the “collection tube” limitation necessarily captures the differences in rates of blood flow between Liu’s device and the invented device.

Applicants respectfully disagree with the Examiner’s interpretation of the “overflow tubes” of Liu as an equivalent of the “collection duct” of the claimed invention. Nonetheless, as discussed at the Interview, Applicants have agreed to amend the claims to recite that the “blood flows through the in-line screen capturing device at a rate determined by gravity.” Liu, by contrast, recommends “precise control” over the flow rate “due to the relative small sizes of the capillaries” through the use of pumps. Col. 8, lines 58-65. For at least this reason, Applicants respectfully submit that the claimed invention cannot be rendered obvious in view of Liu alone.

2. Liu in view of Narang

Claims 7-9, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu, 6,924,107, in view of USP No. 6,020,209 to Narang *et al.* (“Narang”). Applicants respectfully submit that this combination of references does not teach or suggest each and every feature of the claimed invention. As explained above, Liu’s device does not permit “blood flow[ing] though the in-line screen capturing device at a rate determined by gravity.” Narang fails to remedy this deficiency. In fact, Narang, as noted by the Examiner, teaches the use of pumps for fluid control. Office Action, page 12 (citing Narang, col. 5, lines 57-59).

Hence, Applicants respectfully request withdrawal of the § 103 rejections over Liu in view of Narang.

3. Liu in view of Bashir and Yamanishi

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu in view of U.S. App. Pub. No. 2001/0053535 to Bashir *et al.* (“Bashir”) and U.S. App. Pub. No. 2003/0134416 to Yamanishi *et al.* (“Yamanishi”). Applicants respectfully submit that the combination of Liu, Bashir and Yamanishi does not satisfy the requirements for a *prima facie* at least because the combination does not teach or suggest each and every feature of the claimed invention. As explained above, neither Liu’s or Narang’s devices permit “blood flow[] though the in-line screen capturing device at a rate determined by gravity.” Bashir and Yamanishi fail to remedy this deficiency. Therefore, the combination of Liu, Bashir and Yamanishi cannot render claim 20 obvious.

Accordingly, Applicants respectfully request withdrawal of the § 103 rejection over Liu in view of Bashir and Yamanishi.

CONCLUSION

Applicants believe that the present application remains in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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